

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/698,180

Applicant(s)

UPADHYA ET AL.

Examiner

Ljiljana (Lil) V. Ciric

Art Unit

3744

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Ljiljana (Lil) V. Ciric/
Primary Examiner, Art Unit 3744

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments with regard to the objections and rejections previously cited by the examiner are generally NOT found to be persuasive. For example, applicant argues i(n response to the examiner's previously cited objection to the drawings as failing to show the claimed subject matter) that Figures 1A and 2 show the overhang as recited in the claims and that a plurality of micro-scaled regions 303 are shown in Figure 3A; applicant's arguments are irrelevant, however, because NONE of the originally filed drawings show an overhang as cited in the claims AND the newly recited plurality of substantially parallel micro-scaled regions IN COMBINATION in the same embodiment as now recited in the claims. Furthermore, there is NO support for the same new combination of elements anywhere in the originally filed disclosure, as already noted by the examiner. Therefore the previously cited objection to the drawings stands and cannot be corrected without adding more new matter. Applicant's arguments with regard to the previously cited objections to the specification are similarly found non-persuasive. Contrary to applicant's arguments, the term "exhaust" does NOT have an art-accepted meaning that is synonymous with and commensurate in scope to the term "outlet"; for example, the term "exhaust" is narrower, and carries with it an art-specific connotation of a waste gas or fluid stream associated with combustion or another chemical process beyond heat exchange for which there is no support in the originally filed disclosure. Applicant is required to not only avoid introducing new matter into applications but is also required to maintain consistent terminology among terms appearing in the specification, the claims, the abstract in order to comply with all of the requirements for a clear and complete disclosure and for clear and definite claims. Applicant's arguments with regard to the previously cited rejections under 35 USC 112, first and second paragraphs, are similarly non-persuasive and fail to address the examiner's point that applicant now appears to be trying to claim a combination of elements which was never previously disclosed as such. Finally, in response to applicant's arguments that the final Office action is incomplete because it lacks a prior art rejection, the examiner notes that prior art rejections are not a required part of final Office actions or any other Office actions if there is no appropriate prior art rejection to be made at the time; the MPEP merely requires that the examiner not stop looking for appropriate prior art upon making an indefiniteness rejection of the claims under 35 USC 112, second paragraph. The MPEP does not require the examiner to make prior art rejections where no appropriate art has been found. On the other hand, if the applicant believes to have found prior art themselves which in the applicant's opinion should be used in rejecting any or all of the pending claims, the applicant is urged to come forward with and clearly identify the same as required under full disclosure requirements.

Continuation of 13. Other: The information disclosure statement filed on October 6, 2008 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has NOT been considered..